

## **REMARKS**

Reconsideration of this application in light of the present amendment and remarks is respectfully requested.

Claims 1-12 and 14-16 have been rejected.

Claims 13 and 17-18 were previously canceled.

Claims 15-16 have been canceled, without prejudice.

Claims 1, 2, 10 and 14 have been amended.

Claims 1-12 and 14 are pending in this application.

### **35 U.S.C. §101**

Claims 1-12 have been rejected under 35 U.S.C. §101 as not falling within one of the four statutory categories of invention. This rejection is respectfully traversed.

Claim 1 has been amended to incorporate portions of apparatus claim 14 so as to fall into a statutory category of invention, by being tied to a particular apparatus, by including the application of the method steps in the operation of a packet data unit.

For the foregoing reasons, applicants respectfully request that the above rejection be withdrawn.

### **35 U.S.C. §112, first paragraph**

Claims 14-16 have been rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make or use the invention. In particular, the Examiner states that claim 14 is a single means claim and is thus non-enabling. Claim 14 has been amended to incorporate the means of claims 15 and 16 (which are subsequently canceled). Claim 14 now has multiple means to enable one skilled in the art to make or use the invention.

For the foregoing reasons, applicants respectfully request that the above rejection be withdrawn.

### **35 U.S.C. §112, second paragraph**

Claims 1-12 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. In particular, the Examiner states that claim 1 does not recite a positive method step.

Independent claim 1 has been amended to comply with 35 U.S.C. §112, second paragraph, and to particularly point out and distinctly claim the subject matter which applicants regard as the invention. In particular, claim 1 has been amended to recite positive method steps.

For the foregoing reasons, applicants respectfully request that the above rejection be withdrawn.

### **35 U.S.C. §102(b)**

Claims 1, 2, 5 and 14-16 have been rejected under 35 U.S.C. §102(b) as being anticipated by Watanabe et al. (US 5,991,642, hereinafter “Watanabe”). This rejection is respectfully traversed.

Claims 1 and 14 have been clarified to provide a way of determining the initial coding scheme for a communication with a subscriber unit based on channel coding schemes previously used for communications with that (or other) subscriber units in the cell. Support for which can be found in the second full paragraph of page 13 and the last paragraph of page 13 continuing on to page 14, the last paragraph of page 8, and claims 2 and 6.

Watanabe discloses (col. 8 lines 54-56) storing channel conditions into a table. These conditions are associated with channel coding schemes used during these channel conditions. Thereafter when particular channel conditions are experienced a base station will choose a channel coding scheme that was previously used in those same channel conditions. With Watanabe, when a communication is to be initiated, a channel condition must first be determined, then that channel condition is compared to stored channel conditions in a table to find a corresponding coding scheme to use. In contrast, in applicants’ invention, one only need look in a table for the last coding scheme used by that (or other) subscribers in the cell, which is much less processor intensive, since no channel condition measurements need be made. Applicants’ invention does not consider channel conditions when choosing an initial coding scheme, unlike Watanabe, and therefore provides a much simpler solution. Moreover, Watanabe is not concerned with what other subscriber units in the cell have used for their coding schemes in the past with respect to an initiating subscriber unit.

Accordingly, applicants respectfully submit that amended independent claims 1 and 13 are patentable and non-obvious over the cited art.

Claim 2 reflects that a selected channel coding scheme may be one previously used by other subscriber units in the cell. Applicants disagree that Watanabe teaches this. Watanabe teaches the storage of previously experienced channel conditions. Watanabe does not teach selecting a coding scheme (without consideration of channel conditions) that were previously used by other subscriber units. Moreover, claims 2 and 5 are dependent on amended claim 1,

hereby incorporated by reference, and are therefore deemed allowable as well for the same reasons.

Accordingly, applicants respectfully request that this rejection be withdrawn.

**35 U.S.C. §103(a)**

Claims 3, 4, 6 and 11 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Watanabe. This rejection is respectfully traversed.

Regarding claim 3, Watanabe does not describe recording a channel coding scheme used for each block of data. Although it may be known that recordings can be made at any time, applicants respectfully submit that it is not known to record a channel coding scheme per blocks of data, which is not a timing issue at all. Moreover, the known art does not envision why it would be beneficial to do so.

Regarding claim 4, Watanabe does not describe recording a channel coding scheme at the end of a communication. Although it may be known that recordings can be made at any time, applicants respectfully submit that it is not known to record a channel coding scheme at the end of a communication, which is not a timing issue at all. Moreover, the known art does not envision why it would be beneficial to do so.

Regarding claim 11, Watanabe does not describe using previous channel coding schemes, as argued with respect to claim 1 above, therefore Watanabe could not have envisioned using said previous coding scheme only within a certain time period. Moreover, this had nothing to do with the timing of recording, but is instead concerned about a time period after a recording has been made. Applicants respectfully submit that it is not known to use a previous channel coding scheme, and therefore it could not have been known to not use such previous channel coding scheme if it is too old. Moreover, the known art does not envision why it would be beneficial to do so.

Regarding claim 6, the Examiner admits that Watanabe does not describe using previous channel coding schemes commonly used by other subscribers, but that it is obvious to do so. Applicants submit that if it is obvious to do this than it should have been taught somewhere in the prior art, which it is not. Moreover, the known art does not envision why it would be beneficial to do so.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). In this case, for the reasons stated above, all the claim limitations are not taught or suggested by the prior art. Thus, the Watanabe reference clearly fails to render obvious the claims.

Moreover, a proposed modification or combination of prior art cannot be made if the prior art does not suggest the desirability of the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). As mentioned above and in the Applicant's specification, it is a substantial benefit to use the claimed invention because it permits the simple selection of a previously used coding scheme by one or other subscriber units without consideration of any other information such as measurements. Watanabe, for the reasons mentioned above, simply does not suggest the desirability of the claimed invention since it requires extraneous information before a coding scheme can be chosen. Moreover, the application that it is known to time some things is not applicable for the reasons stated above.

It is respectfully submitted that the type of hindsight guessing on how something could have worked is insufficient for purposes of 35 U.S.C. 103(a). The applicants' specification specifically teaches how to directly use previously stored coding schemes of subscriber unit(s) in a cell to choose an initial coding scheme in a communication. The deficiencies of the Watanabe cannot be remedied by the conclusions about what is well known or what one skilled in the art could have done. *In re Zurko*, 258 F.3d 1379, 1385-1386 (Fed. Cir. 2001) (Assessment of basic knowledge and common sense in the art must be based on evidence in the record and cannot be based on unsupported assessment of the prior art).

Moreover, pending claims 2-12 depend on independent claim 1. These dependent claims are believed to be allowable for at least the same reasons discussed above with respect to claim 1. See *In re Fine*, 837 F.2d at 1076 (If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.).

Accordingly, applicants respectfully request that this rejection be withdrawn.

### **35 U.S.C. §103(a)**

Claims 7-10 and 12 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Watanabe, and further in view of Budka et al. (US Publ. 2003/0198312, hereinafter "Budka"). This rejection is respectfully traversed.

Watanabe has been distinguished over previously. Applicants' distinguishing remarks providing the benefits of applicants' invention and disadvantages of Watanabe, to the extent applicable, are hereby incorporated by reference.

Budka describes a method for selecting a channel coding scheme by using both a block error rate and bit error rate. In case of a low block error rate, the code is selected as required by the bit error rate, otherwise the code is selected as required by the block error rate. Both cases require channel measurements including carrier-to-interference ratios mapped to channel coding schemes. These measurements are actually used to select a channel coding scheme. Although Budka may describe performing separate coding scheme selection for an uplink and downlink,

the selection still depends on channel measurements, unlike applicants' base claim 1. Therefore, Budka has the same failings as Watanabe.

Moreover, claims 7-10 and 12 are dependent on amended claim 1, hereby incorporated by reference, and are therefore deemed allowable as well for the same reasons.

Accordingly, applicants respectfully request that this rejection be withdrawn.

The other references of record have been reviewed and applicant's invention is deemed patentably distinct and nonobvious over each taken alone or in combination.

For the foregoing reasons, applicants respectfully request that the above rejections be withdrawn.

Inasmuch as this amendment distinguishes all of the applicants' claims over the prior art references, for the many reasons indicated above, passing of this case is now believed to be in order. A Notice of Allowance is earnestly solicited.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Authorization is hereby given to charge any fees necessitated by actions taken herein to Deposit Account 50-2117.

Respectfully submitted,  
**Stoiber et al.**

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